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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/349,713 07/08/99 BUCHHOLZ H MERCK-1900

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EXAMINER

SHARAREH, S

ART UNIT

PAPER NUMBER

1619

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/349,713

Applicant(s)
Buchholz et al

Examiner
SHAHNAM SHARAREH

Art Unit
1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 25, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 16-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Amendment filed on February 15, 2001 has been entered.

1. Newly submitted claim 16-25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claim is directed to a distinct invention which is related as process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said product and method of using. (MPEP § 806.05(I)).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicant's amendments and arguments obviated the rejection of claim 8, 11 under 35 U.S.C. 112, second paragraph.

3. The Affidavit filed on February 15, 2001 under 37 CFR 1.131 has been considered but is ineffective to overcome the 35 U.S.C. 102(a) as being anticipated by Beirsdorf AG DE 19753983 (abstract) and 35 U.S.C. 102(e) as being anticipated by Gers-Barlag et al US Patent 5,952,39. No verified translation of German Application No. 19809304 is submitted. Accordingly, there is no evidence submitted to establish conception, diligence, or reduction to practice from a date prior to the date of reduction to practice of the cited references.

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4. Claims 1-15 stand rejected under 35 U.S.C. 102(a) as being anticipated by Beirsdorf AG DE 19753983 (abstract) for the reasons set forth in the Office Action filed on August 5, 2000, Paper No. 4.

5. Claims 1-10, 12-15 stand rejected under 35 U.S.C. 102(e) as being anticipated by Gers-Barlag et al US Patent 5,952,391 for the reasons set forth in Paper No. 4.

6. Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al US Patent 5,952,391 for the reasons set forth in Paper No. 4.

7. Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al US Patent 5,952,391 in view of Bean US Patent 4,132,782, and Beirsdorf AG DE 19753983 (abstract) for the reasons set forth in Paper No. 4

New Grounds of Rejection

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6, 8, 12, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawruk et al US Patent 5,478,579.

Sawruk discloses pharmaceutical compositions comprising isoquercitrin (col 4 lines 45-51, claims 1, 4, 8). Therefore, Sawruk meets the limitations of the instant claims.

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10. Claims 1-6, 7, 15 rejected under 35 U.S.C. 102(b) as being anticipated by JP 06183940 (abstract).

. JP 06183940 disclose dentifrices comprising isoquercitrin (see abstract). Accordingly, JP patent meets the limitations of the instant claims.

11. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzendorfer et al WO 96/18381 in view of Bean US Patent 4,132,782 .

Lanzendorfer et al disclose the use of flavonoid containing compositions for topical use in combination with various vitamins, other flavone and UVB or UVA filters (see abstract, page 3-5, 43, 54-60, claims 1-7). Lanzendorfer further teach the use of other type flavone even from commercially available flavonoid containing plant extracts with his compositions (see page 43). Lanzendorfer specifically fail to teach a topical isoquercitrin composition for treatment of herpes simplex.

Bean is used to show the use of isoquercitrin as an antiviral in topical compositions (see col 4). In fact the antiviral properties of flavonoid containing compounds such as isoquercitrin are well described in the art. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose "the idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). Accordingly, it would have obvious to one of ordinary skilled in the art at the time of invention to add isoquercitrin composition as the flavonoid of choice to


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the compositions of Lanzendorfer, because one of ordinary skill in the art would have had a reasonable expectation to succeed in enhancing the antiviral activity of Lanzendorfer's topical compositions. Furthermore, optimizing the concentration of isoquercitrin and other pharmaceutical excipient would have been well within the purview of an ordinary routiner.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh, PharmD whose telephone number is (703) 306-5400. The examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone number for this Group is 703-308-4556. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1235.

sjs 4/28/2001


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